



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,667	10/06/2000	Peter Morris	29841/36636	9526

7590

02/11/2003

David W Clough
Marshall O'Toole Gerstein Murray & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402

EXAMINER

LIU, SAMUEL W

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 02/11/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,667

Examiner

Samuel W Liu

Applicant(s)

MORRIS ET AL.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-90 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 46-90 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Preliminary amendment filed 19 March 2002 (Paper No. 9) as cancellation of claims 1-45 and addition of new claims 46-90 have been entered. The following Office action is applicable to the pending claims 46-90.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 46-48, 56-70 and 85-87, drawn to the method of recombinantly producing a mistletoe lectin polypeptide in host cells.

Group II, claims 49-54 and 78-80, drawn to a mistletoe lectin polypeptide and a pharmaceutical composition comprising the polypeptide thereof.

Group III, claims 55 and 88, drawn to the method of producing a polynucleotide from mistletoe cells including mutagenesis, wherein claim 88 is directed to a mistletoe cell).

Group IV, claims 71-77, drawn to a pharmaceutical composition comprising polynucleotide encoding a mistletoe lectin polypeptide.

Group V, claim 81, drawn to the method of producing a medicament for treating uncontrolled cell growth (*e.g.*, cancer).

Group VI, claims 82-84, drawn to the method of producing a medicament for immune reaction in mistletoe cells.

Group VII, claims 85-87, drawn to the method of producing a mistletoe lectin polypeptide in a transgenic mistletoe plant.

Art Unit: 1653

Group VIII, claim 88, drawn to method of preparing a polynucleotide encoding a mistletoe lectin polypeptide in a transgenic mistletoe plant.

Group IX, claims 89-90, drawn to the method of *in vitro* producing a mistletoe lectin polypeptide by chemical modification.

The invention listed as Groups I-IX do not related to a single general invention concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack he same or corresponding special technical features for the following reasons:

The method of claims 46 and 85 are obvious over Sweeney, E. C. *et al.* (*J. Mol. Biol.* (1993) 234, 1279-1281). Prior to the effective filing date of the instant application, Sweeney *et al.* teach mistletoe lectin polypeptide A and B chains, and a method of purification and the therapeutic use of the polypeptides thereof (see page 1280). Thus, the method as claimed does not constitute a special technical feature linking all claims, as defined by PCT Rule 13.2 and 37 CFR 1.475(a), as a single contribution over the art, and a holding of lack of unity is therefore proper.

~~Note that claim 87 depends from the cancelled claim 40. See also claims 62-65.~~

Applicants are required to amend the claims and identify any remaining claims readable thereon.

Applicants are advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu, Ph.D. whose telephone number is 703-306-3483. The examiner can normally be reached Monday-Friday 9:00 -5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communication and (703) 305-3014 for the after final communication. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



Samuel Wei Liu, Ph.D.
January 2003



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER